

REMARKS

Claims 1-27 stand rejected. With this amendment, claims 3-6, 12-13, 15-18, 24-27 are cancelled. New claims 28-32, 33-35, and 36-37 that depend from independent claims 1, 9, and 20, respectively, have been added. Independent claims 1, 9, and 20 have been amended. These amendments are intended to more clearly illustrate certain features of the present invention, not to distinguish over the cited references.

Claims 1-6, 20, 23-27 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,256,737 (*Bianco*). Applicant respectfully traverses the § 102 rejections of independent claims 1 and 20.

Independent claim 1 recites a method of sending a package that includes “scanning a two-dimensional bar code that has been associated with the package” and “decoding the two-dimensional bar code to obtain the receiver’s previously provided biometric information.” Independent claim 20 recites a similar feature that includes “encoding biometric information...so as to be capable of being scanned as a two-dimensional bar code” that is capable of being “decoded to recover...the user’s previously provided biometric information.” As set forth in MPEP § 2131, a claim is anticipated under 35 U.S.C. § 102(e) only if each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Bianco* fails to show or teach the aforementioned features recited by claims 1 and 20.

Bianco utilizes biometric measurements for the authentication of users to enterprise resources. (2:53-55). *Bianco* relies on a biometric server to store the engine and collections of data required to authenticate users. (2:56-58). Referring to Figure 5 of *Bianco*, a biometric server

104 is shown that stores collections of biometric templates 502. (17:38-39). A biometric template 502 “stores the user’s unique biometric measurement...which is then used to match against the user’s ‘live’ biometric measurement when the biometric device is attempting to identify the user.” (17:44-48). The biometric templates 502 are stored in the biometric server 104 as database objects. (23:17-29). When a user wants to gain access to an enterprise resource, the user is prompted for live biometric information that is matched with the biometric information stored in the database. (8:13-17).

Unlike *Bianco*, the claimed features of the present invention include using a “two-dimensional bar code” to obtain previously provided biometric information. In essence, the two-dimensional bar code becomes a “portable data file” and is well suited, for example, for applications where it is impractical to store information in a database or where a database is not accessible when and where a package’s bar code is read. Biometric information decoded from the two-dimensional bar code is compared with current biometric information to ensure that a package is delivered to its intended recipient.

In column 10, *Bianco* illustrates just one of many possible problems with relying on a database or server to make available previously provided biometric information. To guard against outages and failures, the *Bianco* system employs alternate biometric servers 110 that serve as backup or standby servers. (10:28-29). In the event the primary server fails, the alternate biometric server 110 becomes active and takes over the responsibility of authenticating users. (10:31-33).

With the present invention, previously provided biometric information is encoded in a two-dimensional bar code. When identification of a party is desired, the previously provided biometric information is not provided by a server or database, but rather, decoded from the two-dimensional bar code and compared with the party's current biometric information. *Bianco* simply does not teach or suggest using a two-dimensional bar code to decode previously provided biometric information. For at least this reason, Applicant respectfully requests that the Examiner withdraw the § 102 rejections of independent claims 1 and 20 and also claims 2-6 and 23-27 depending thereon, respectively.

Claims 7-8 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Bianco*, in view of U.S. Patent No. 5,869,819 (*Knowles*). Claims 7-8 depend from independent claim 1. Claims 21-22 depend from independent claim 20. For the reasons already mentioned, independent claims 1 and 20 are believed to be in condition for allowance. Therefore, dependent claims 7-8 and 21-22 must *a fortiori* also be allowable, since they carry with them all the limitations of the independent claims to which they ultimately refer.

Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Knowles*, in view of *Bianco*. Applicant respectfully traverses the Office's § 103 rejection of independent claim 9. Applicant submits that, contrary to MPEP § 2143, the Office has failed to make out a *prima facie* case of obviousness in that the Office has (1) failed to cite references that teach or suggest all of the elements recited in the rejected claims; (2) failed to show or cite where in the prior art there is a suggestion or motivation to combine the references; (3) failed to show or cite where in the prior art there exists a reasonable expectation of success to combine reference teachings.

As already shown, *Bianco* does teach, hint, or suggest using a two-dimensional bar code to decode previously provided biometric information. *Knowles* is equally silent with regard to this claimed feature of the present invention. *Knowles* discloses an “Internet Scanning System” for reading URL-encoded bar code symbols. (2:40-42). The bar code is scanned to look up websites of interest. (10:8-11,40-42). The scanned URL is provided to an Internet browser program so that the information associated with the URL is automatically accessed by the Internet Scanning System. (9:57-61).

Contrary to *Bianco* and *Knowles*, independent claim 9 recites a scanner for scanning a two-dimensional bar code that “encodes previously provided biometric information”, and a decoder “for decoding the user’s previously provided biometric information from the two-dimensional bar code.” *Bianco* and *Knowles* do not teach or suggest decoding desired content (i.e., previously provided biometric information) from a two-dimensional bar code. Instead, *Bianco* stores desired content in a database server, and *Knowles* retrieves the desired content from an Internet website. For at least this reason the rejection of independent claim 9 and dependent claims 10-19, depending thereon, respectively, should be withdrawn and the claims be allowed.

The Office alleges that “it would have been obvious to one skilled in the art at the time of the invention was made to modify *Knowles*’ method and system in conjunction with *Bianco*’s system and method to emulate an invention that deals with biometric measurements and scanning a two-dimensional bar code, which additionally verifies the products data and its origin.” (Office action p. 8). However, as already shown, neither *Bianco* nor *Knowles* teach or suggest using a two-dimensional bar code to encode previously provided biometric information so that a

comparison with current biometric information may be made without reference to a secondary source, such as a database or the Internet to obtain the previously stored data. Moreover, *Bianco* and *Knowles* are directed to different fields of use. *Bianco* is intended to protect enterprise resources from unauthorized access and *Knowles* is directed to an Internet Scanning System for retrieving information from the Internet.

Section 2143 of the MPEP also requires that the teaching or suggestion to combine references must be found in the prior art, not in the Applicant's disclosure. Section 2143 states that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Finally, the MPEP notes that a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references.

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of hindsight reconstruction using the applicant's specification) to make the necessary changes in the disclosed device or method. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Office has failed to show or cite where in *Knowles* or *Bianco* there exists a reasonable expectation of success if the reference teachings are combined, as required by § 2143 of the MPEP. In fact, the Office is silent as to this requirement for making out a *prima facie* case of obviousness.

There is no statement or inference in *Knowles* or *Bianco* that would suggest that the references could be successfully combined. The disclosures of these references are considerably different. *Knowles* is directed to an Internet Scanning System for retrieving content from the Internet, and *Bianco* discloses a system for protecting enterprise resources from unauthorized access.

The references simply were not intended to be modified or combined as suggested by the Office. Even if the proposed combination occurred, it would still be unable perform the claimed features of the present invention. Furthermore, if there is no motivation to combine found in the references, clearly then, the references cannot show or even implicate a reasonable expectation of success, which is required to make out a *prima facie* case of obviousness. Therefore, for at least this reason, Applicant respectfully requests that the rejection of independent claim 9 dependent claims 10-19 depending thereon be withdrawn and the claims be allowed.

New claims 28-32, 33-35, and 36-37 that depend from independent claims 1, 9, and 20, respectively, are provided in the section above, titled "Listing of Claims." For the aforementioned reasons, these claims are believed to be allowable.

CONCLUSION

Applicant believes this reply to be fully responsive to all outstanding issues and places this application in condition for allowance. Reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned attorney at 713-934-4079 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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